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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/812,315

03/30/2004

Mechthild Rieping

7909/81000

1764

7590  
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10/22/2007

EXAMINER

KIM, ALEXANDER D

ART UNIT

PAPER NUMBER

1656

MAIL DATE

DELIVERY MODE

10/22/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/812,315

Applicant(s)

RIEPING, MECHTHILD

Examiner

Alexander D. Kim

Art Unit

1656

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 09/28/2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): 35 USC 112, first paragraph, enabling deposit in Claim 25.  
6. ☒ Newly proposed or amended claim(s) 13-20 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: 13-20.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 21-26.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.



**RICHARD HUTSON, PH.D.  
PRIMARY EXAMINER**

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' arguments in the amendment filed on 09/28/2007 have been fully considered. However, applicant's arguments are not found persuasive to overcome the outstanding rejections [i.e., 35 USC 112, second paragraph; 35 USC 102(b); and 35 USC 102(a)] as set forth in the Final Office action mailed on 06/12/2007 for the reasons of record stated therein. Applicants argue that "the genes recited in claims 21 and 22 are confined to the particular species in the specification but the doctrine of equivalents still applies", wherein the equivalent should be interpreted by courts during litigation, not during the prosecution. Thus, the claims 21 and 22 are not considered to be indefinite. However, as noted previously, it is unclear if the claims are limited to the one species disclosed in the specification (pages 12-15) or to any gene from other organism which is considered to be an equivalent. Applicants argue "there is only one glucose transport pathway in cell that is termed the PEP-dependent phosphotransferase (PTS) pathway", and the PTS pathway is not present in the cells disclosed in the references since the references expressly refer to "PTS-" cells. However, the recitation of "a PEP-dependent phosphotransferase (PTS) pathway" in Claim 23 is broader than the disclosure by references. It encompasses any pathway that transport glucose because a glucose or molecule transported (by any pathway into the cell would be phosphorylated) and broken into PEP; thus, said any pathway transporting glucose is encompassed by the limitation. Furthermore, the Hernandez-Montalvo et al. teach there is more than one glucose transport pathway (see the first sentence of Abstract). Thus, the instant 35 USC 102(b) and (a) rejections are maintained..

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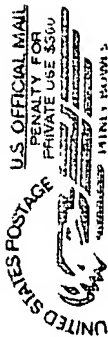
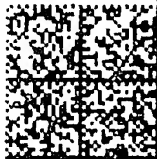
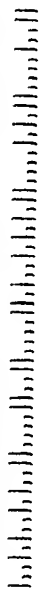
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